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EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/394,341

Applicant(s)

MORAG ET AL.

Examiner

Milan S Kapadia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32, 67 and 69-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32, 67, and 69-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 09 October 2002. Claims 1-32 and 67-76 are pending. Claims 1, 67, and 69 have been amended. Claim 68 has been canceled.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 14, 15, 19, 21, 25, 26, 27, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318) in view of Sato et al. (5,911,687) and further in view of Falchuk et al. (6,256,613).

(A) As per claim 1, Hawkins teaches a method of messaging upon a network comprising:

using a first medical message wizard by said patient on said patient

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operated computer further comprising;

generating an educated query message (Hawkins; col. 3, lines 35-39; the examiner interprets the "client" as the "patient operated computer"); and

sending said educated query message to one of said workflow engine addresses (Hawkins; col. 3, lines 39-40; the examiner interprets the "server" as the "workflow engine"); and

performing a medical profiler process by said workflow engine further comprising

receiving said educated query message at said workflow engine address (Hawkins; col. 3, lines 39-40;

processing said received educated query message, to create a processed, received educated query message (Hawkins; col. 3, lines 39-40; the examiner interprets "new, related queries" as "processed received educated query messages");

generating a patient medical query message from said processed, received educated query message, said patient medical query message comprising said processed, received educated query message (Hawkins; col. 3, lines 40-41; the examiner interprets "new queries" as "patient query message"); and

sending said patient medical query message to a corresponding physician address (Hawkins; col. 3, lines 40-42; the examiner interprets the "web server" as a computer operating at a "physician address" ); and

using a second medical message wizard on said first physician operated computer at said corresponding physician address further comprising:

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receiving said patient medical query message (Hawkins; col. 3, lines 42-44; the examiner interprets the "web server" as the "physician operated computer");

processing said received patient medical query message to create a processed, received patient medical query message (Hawkins; col. 3, lines 40-42; the examiner interprets the messages used by "second query protocol by the web server" as a "processed received patient medical query message");

Hawkins fails to expressly teach the messaging system involves patients and physicians comprising a computer operated by a physician and a computer operated by a patient and generating a patient message log entry in a medical profile from said processed, received educated query message. However, these features are old and well known in the art, as evidenced by Sato's teachings with regards to a messaging system involving patients and physicians comprising a computer operated by a physician and a computer operated by a patient and generating a patient message log entry in a medical profile from said processed, received educated query message (Sato; abstract; the examiner interprets the "electronic case record file" as a form of a "medical profile.") It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the system taught by Hawkins with Sato's teaching with regards to a messaging system involving patients and physicians comprising a computer operated by a physician and a computer operated by a patient and generating a patient message log entry in a medical profile from said processed, received educated query message, with the motivation of providing a patient located in a remote area a remote examination and treatment

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services of high satisfaction and medical treatment related services other than examination and treatment regardless of the location of the doctor/facilities relative to the patient (Sato; col. 1, line 66-col. 2, line 6).

Hawkins and Sato collectively fail to teach generating a physician-viewable patient medical query message from said processed, received patient medical query message; and displaying said physician-viewable patient medical query message. It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Hawkins and Sato to generate a physician-viewable patient medical query message from said processed, received patient medical query message; and display said physician-viewable patient medical query message, with the motivation of enabling said physician to view and review said patient medical query message.

As per the term "message wizard" in claim 1, note Hawkins' teachings with respect to the use of easy-to-fill forms in order to submit messages or queries (Hawkins; col. 12, lines 40-67).

Hawkins and Sato collectively also fail to expressly teach said patient medical query message comprises an attached medical profile. However, this feature is old and well known in the art, as evidenced by Falchuk's teachings with regards to said patient medical query message comprises an attached medical profile (Falchuk; col. 2, lines 11-26). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Hawkins and Sato, with Falchuk's teaching with regards to these

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limitations, with the motivation of including additional information with the request (Falchuk; col. 2, lines 16-18).

(B) Claims 2, 14, 15, 19, 21, 25, 26, 27, 30, and 31 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 7; section 10(B-G), pages 7-11 and section 16(A-B), pages 28-31), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

3. Claims 3, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Falchuk et al. (6,256,613) as applied to claim 2 above and further in view of Colvin (5,825,881).

(A) Claims 3, 4, and 5 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 7; section 11(A-C), pages 11-15), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

4. Claims 6, 7, 8, 9, 10, 13, 28, 29, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Falchuk et al. (6,256,613), and Colvin (5,825,881) as applied to claim 3 above.

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(A) Claims 6, 7, 8, 9, 10, 13, 28, and 29, have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 7; section 12(A-G), pages 16-22), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

(B) Claim 67 repeats features of amended claim 1 and claim 13 and therefore is rejected for the same reasons given above in the rejection of amended claim 1 and 13 and incorporated herein.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Colvin (5,825,881), and Falchuk et al. (6,256,613 ) as applied to claim 10 above and further in view of Merck-Medco ("Merck-Medco Announces Interactive Web Site," News Release, October 27, 1998).

(A) Claim 11 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 7; section 13(A), pages 22-24), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

6. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Colvin (5,825,881), and Falchuk et al. (6,256,613) as applied to claims 7, 8, and 10 above and further in view of Business



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Wire ("Merck-Medco and Physicians' Online Pilot New suite of Internet Applications To Facilitate Physician and Pharmacist Communications At the Point of Prescribing," Business Wire, October 22, 1998).

(A) Claim 12 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 7; section 14(A), pages 24-26), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

7. Claims 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318) Sato et al. (5,911,687), and Falchuk et al. (6,256,613) as applied to claim to claim 15 above and further in view of Spurgeon (5,890,129).

(A) Claims 16, 17, and 18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 7; section 15(A-B), pages 26-28), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

8. Claims 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Falchuk et al. (6,256,613) as applied to claim 1 above and further in view of Pinsky et al. (5,469,353).

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(A) Claims 22, 23, and 24, have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 7; section 17(A-B), pages 31-33), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Falchuk et al. (6,256,613) as applied to claim 2 above and further in view of Donoahue et al. (5,987,480).

(A) Claim 20 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 7; section 18(A), pages 33-35), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), and Falchuk et al. (6,256,613) as applied to claim 31 above and further in view of Gray (6,149,585).

(A) Claim 32 has not been amended and is rejected for the same reasons given in

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the previous Office Action (paper number 7; section 19(A), pages 35-36), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

11. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Colvin (5,825,881), Falchuk et al. (6,256,613 ), and Pinsky (5,469,353 as applied to claim 67 above.

(A) Claim 69 repeats features of claim 23 and therefore is rejected for the same reasons given above in the rejection of claim 23 and incorporated herein.

12. Claims 70, 71, 72, 73, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Colvin (5,825,881), Falchuk et al. (6,256,613 ), Pinsky (5,469,353)), Merck-Medco ("Merck-Medco Announces Interactive Web Site," News Release, October 27, 1998), and Business Wire ("Merck-Medco and Physicians' Online Pilot New suite of Internet Applications To Facilitate Physician and Pharmacist Communications At the Point of Prescribing," Business Wire, October 22, 1998) as applied to claims 11, 12, and 69 above.

(A) Claims 70-74, have not been amended and are rejected

for the same reasons given in the previous Office Action (paper number 7; section 21(A-D), page 37), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

13. Claims 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (6,343,318), Sato et al. (5,911,687), Colvin (5,825,881), Falchuk et al. (6,256,613), Pinsky(5,469,353), Merck-Medco ("Merck-Medco Announces Interactive Web Site," News Release, October 27, 1998), and Business Wire ("Merck-Medco and Physicians' Online Pilot New suite of Internet Applications To Facilitate Physician and Pharmacist Communications At the Point of Prescribing," Business Wire, October 22, 1998) as applied to claims 9 and 70 above and further in view of Masuo et al. (6,154,444).

(A) Claims 75 and 76, have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 7; section 22(A-B), pages 37-39), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

### ***Response to Arguments***

14. Applicant's arguments with respect to amended claims 1, 67, and 69 have been considered but are moot in view of the new ground(s) of rejection.

(A) At pages 6-8 of the 10/09/02 communication, Applicant argues each of the applied references individually.

In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, the features newly added and entered in the amendment filed 10/09/02, they have been shown to be fully disclosed by or obvious in view of the collective teachings of the applied references, as discussed above in detail within the preceding sections of the present Office Action.

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

2. Applicant's arguments filed 10/09/02 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 10/09/02.

(A) At page 6 of the 10/09/02 response, Applicant argues that "...for the purpose of the invention, 'processing' merely involves data collection and routing ..." in reference to claim 1. In response, it is noted that the features upon which Applicant relies are not recited in the rejected claim (s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In Re Van Geuns*, 988 F. 2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993). Further, even if such a limitation were inserted in the claim, this feature is old and well known in the art, as evidenced by, for example, Falchuk, et al. (6,256,613), applied in the present Office Action.

(B) At pages 6 and 7 of the 10/09/02 response, Applicant argues that "There is no indication that the physician-operated computer is a server, or serves the function of a server" in reference to claim 1. In response, it is noted that the features upon which Applicant relies are not recited in the rejected claim (s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In Re Van Geuns*, 988 F. 2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993). Further, even if such a limitation were inserted in the claim, this feature is old and well known in the art, as evidenced by, for example, Falchuk, et al. (6,256,613), applied in the present Office Action. In particular, Falchuk clearly teaches a physician-operated computer that directs a response to a client "at the instigation of the operator."

Furthermore, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against amended claims 1, 67, and 69. As

such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

### ***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



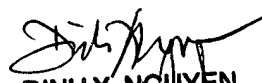
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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
mk

  
DINH X. NGUYEN  
PRIMARY EXAMINER

December 19, 2002